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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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TAIYO CORPORATION
401 HOLLAND LANE
#407
ALEXANDRIA, VA 22314

EXAMINER

AUGHENBAUGH, WALTER

ART UNIT PAPER NUMBER

1772

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/786,075

Applicant(s)

MINATO ET AL.

Examiner

Walter B. Aughenbaugh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgement of Applicant's Amendments

1. The amendments made in claims 1, 2, 5, 8, 14 and 16 in the Amendment filed on August 22, 2006 (Amdt. A) have been received and considered by Examiner.
2. The cancellation of claim 20 in Amdt. A has been acknowledged by Examiner.
3. New claim 21 presented in Amdt. A has been received and considered by Examiner.
4. The amendment made in the specification in Amdt. A has been received and considered by Examiner.

WITHDRAWN OBJECTIONS

5. The objection to the specification made of record in paragraph 2 of the previous Office Action mailed February 22, 2006 has been withdrawn due to Applicant's amendment in the specification in Amdt. A.

WITHDRAWN REJECTIONS

6. The 35 U.S.C. 112 rejection of claim 5 made of record in paragraph 3 of the previous Office Action mailed February 22, 2006 has been withdrawn due to Applicant's amendment in claim 5 in Amdt. A.
7. The 35 U.S.C. 112 rejection of claim 20 made of record in paragraph 3 of the previous Office Action mailed February 22, 2006 has been withdrawn due to Applicant's cancellation of claim 20 in Amdt. A.

REPEATED REJECTIONS

Claim Rejections - 35 USC § 112

8. The 35 U.S.C. 112 rejection of claims 2, 10, 14 and 16-19 made of record in paragraph 3 of the previous Office Action mailed February 22, 2006 has been repeated for the reasons previously made of record.

Claim Rejections - 35 USC § 103

9. The 35 U.S.C. 103 rejection of claims 1-19 made of record in paragraph 5 of the previous Office Action mailed February 22, 2006 has been repeated for the reasons previously made of record, and for the following reasons that address the amendments made in claims 1, 2, 5, 8, 14 and 16 in Amdt. A: the recitation added at the end of claims 1, 8 and 16 is an optional limitation due to the word “when” and the phrase “can be”, which appears once in each of the last two lines of the claims. The recitation added at the end of claims 1, 8 and 16 is also a method limitation that has not been given patentable weight since the method of forming the material is not germane to the issue of patentability of the material itself, due to the word “when” and the phrases “are fed into a packaging machine”, “simultaneous feeding”, “can be prevented” and “excellent performance of the packaging machine can be achieved”.

In regard to claims 2 and 14, and in further regard to claim 16, the packaging material is “capable of exhibiting the value of the coefficient of dynamic friction” because all materials have a coefficient of dynamic friction. It has been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. *In re Hutchinson*, 69 USPQ 138.

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The basis of rejection of claim 5 under 35 U.S.C. 103 is not affected by the amendments in claim 5 in Amdt. A.

NEW REJECTIONS

Claim Rejections - 35 USC § 103

10. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baker et al. in view of Rahman et al. and in further view Matsunaga et al. for the same reasons that claim 1 is rejected under 35 U.S.C. 103 as made of record in paragraph 5 of the previous Office Action mailed February 22, 2006 since a packaging material is a packaging. The recitation “for a photographic photosensitive material” is an intended use phrase that has not been given patentable weight, since it has been held that a recitation with respect to the manner in which a claimed article is intended to be employed does not differentiate the claimed article from a prior art article satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQd 1647 (1987).

Response to Arguments

11. Applicant’s arguments regarding the 35 U.S.C. 112 rejection of claims 2, 10, 14 and 16-19 presented on page 8 of Amdt. A have been fully considered but are not persuasive.

Applicant has not explained how the amendments in claims 2, 14 and 16 “address the concerns of the Examiner”. In response to Applicant’s first point (that is preceded by “i)”, Applicant has not shown the relevance of the statement “[t]he claims relate to a product”; the Office clearly recognizes this. Applicant has not provided any support for the statements made in the second and third points; it is not at all clear upon reading the claims that the subject matter discussed in the second and third points are what Applicant intends the claims to recite.

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12. Applicant's arguments regarding the 35 U.S.C. 103 rejection of claims 1-19 presented on pages 9-10 of Amdt. A have been fully considered but are not persuasive.

An argument that is made with support cannot be gleaned from pages 9 or 10 of Amdt. A. Applicant's statement that "it is preferable..." supports the position of the Office made of record in this Office Action that the recitation added at the end of claims 1, 8 and 16 is an optional limitation due to the word "when" and the phrase "can be", which appears once in each of the last two lines of the claims. Applicant has not specifically addressed the 35 U.S.C. 103 rejection of record.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B. Aughenbaugh whose telephone number is 571-272-

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1488. While the examiner sets his work schedule under the Increased Flexitime Policy, he can normally be reached on Monday-Friday from 8:45am to 5:15pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is to 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Walter B. Aughenbaugh
09/15/06

WBA


JENNIFER C. MCNEIL
SUPERVISORY PATENT EXAMINER
9/16/06